

Docket No.: E0295.70191US00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stephen J. Todd
Serial No.: 10/731,613
Filed: December 9, 2003
For: METHODS AND APPARATUS FOR FACILITATING ACCESS TO
CONTENT IN A DATA STORAGE SYSTEM
Examiner: L. Iwashko
Art Unit: 2186
Confirmation No. 4751

Certificate of Mailing Under 37 CFR 1.8(a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 10/5/06

Richard F. Giunta, Registration No. 36,149

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith are the following documents:

- ☒ Part B - Issue Fee Transmittal
- ☒ Comments on Statement of Reasons for Allowance
- ☒ Amendment After Allowance Under 37 CFR 1.312
- ☒ Check for \$1,700.00
- ☒ Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617) 646-8000, Boston, Massachusetts.

A check in the amount of \$1,700.00 is enclosed to cover the issue fee and patent copies. If the fee is insufficient, the balance may be charged to Deposit Account 23/2825.

Dated: October 5, 2006

Respectfully submitted,

By:

Richard F. Giunta
Registration No.: 36,149
WOLF, GREENFIELD & SACKS, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, Massachu



Docket No.: E0295.70191US00
(PATENT)

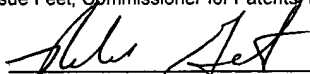
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stephen J. Todd.
Serial No.: 10/731613
Confirmation No.: 4751
Filed: December 9, 2003
For: METHODS AND APPARATUS FOR FACILITATING ACCESS TO
CONTENT IN A DATA STORAGE SYSTEM
Examiner: L. Iwashko
Art Unit: 2186

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Dated: October 5 2006


Richard F. Giunta, Reg. No. 36,149

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Notice of Allowance and Fee(s) Due mailed July 26, 2006 included an Examiner's Amendment and an Examiner's Statement of Reasons for Allowance.

Initially, Applicant notes that two of the claims had minor informalities that Applicant has addressed via a Rule 312 amendment filed concurrently herewith. Applicant further notes that the claims are similar in many respects to proposed claims e-mailed to the Examiner on June 26, 2006. That e-mail and the proposed claims are attached for the record.

There are twelve independent claims allowed. Understandably, in the Statement of Reasons for Allowance, the Examiner did not separately address each independent claim, but indicated that the "claims teach the same concepts" and "differ only in being different embodiments of the invention (method, system, or apparatus)." (Office Action, page 18). The

Statement of Reasons for Allowance discussed the allowability of claim 1, but indicated that the explanation applies to the other independent claims as well. (Office Action, page 18).

Applicant believes that each of the claims is patentable based solely upon the language included therein, and that the Examiner's shorthand reference to the claims teaching "the same concepts" and as purportedly differing only in being different embodiments is not intended to incorporate any limitation from one of the claims into another where it is not present. If the Examiner disagrees, he is respectfully requested to contact the undersigned at the number listed below to discuss how the record can be clarified.

In addition, the Reasons for Allowance indicates that the independent claims are of similar scope but directed to different types of claims (i.e., method, computer readable medium and apparatus). While this is true with respect to some groups of independent claims, it is not true between groups. For example independent claims 1, 11 and 21 form a first group, claims 31, 39 and 47 form a second group, claims 55, 60 and 65 form a third group, and claims 70, 73 and 76 form a fourth group. These groups of claims are not coextensive in scope and must be evaluated independently. Given that, Applicant would like to emphasize for the record that the explanation of the allowability of claim 1 is not intended to incorporate any limitation therefrom into any of the other groups of claims that are different in scope, as each claim is patentable based solely upon the limitations included therein. Once again, if the Examiner disagrees, he is respectfully requested to contact the undersigned at the number listed below to discuss how the record can be clarified.

Applicant also would like to address some of the specific statements about claim 1. First, the Reasons for Allowance states that it is directed to a method "that stores the data of a host." That language does not appear in claim 1, which is directed to a method of processing data in a computer system comprising at least one host and at least one storage system. Second, the Reasons for Allowance indicates that the novelty results from the next part of the claim. Applicant would like to emphasize that claim 1 is patentable over the prior art of record based upon the subject matter recited therein as a whole, as opposed to any particular novel limitation(s). Finally, the Reasons for Allowance asserts that "The fact that this invention necessitates a first and second request in order to successfully process the data in the manner denoted in Claim 1 makes this invention original." Applicant understands this to mean that the

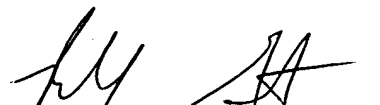
subject matter of the claim as a whole is novel and patentably distinguishes over the prior art of record.

If the Examiner disagrees with any of the foregoing, he is respectfully requested to contact the undersigned at the number listed below so that a discussion can be had about clarifying the record as to the scope of the allowed claims and the reasons for allowance.

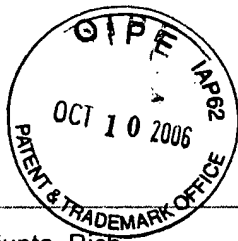
Dated: October 5, 2006

Respectfully submitted,

By:



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Giunta, Rich

From: Giunta, Rich
Sent: Monday, June 26, 2006 8:55 PM
To: 'Lev.Iwashko@uspto.gov'
Subject: Proposed Claim Amendments - 10/731,613 (E0295.70191US00)
Attachments: Proposed Amendment.DOC

Examiner Iwashko,

Here are proposed amendments for the above-referenced application. Each of the independent claims has been amended to incorporate limitations from at least one of its dependent claims.

Please let me know if you have any questions. I assume you will make this email part of the record.

Thanks,
Rich

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6/26/2006